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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,179	06/20/2000	Maura Rooney	BSP2102US02	5883
22852	7590	05/18/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,179

Applicant(s)

ROONEY ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,25,26,28-30,32-39 and 57-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 70-88 is/are allowed.
- 6) ☒ Claim(s) 22,30,34,57,64,68 and 89 is/are rejected.
- 7) ☒ Claim(s) 25,26,28,29,32,33,35-39,58-63,65-67 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 22, 30, 34, 57, 64, 68 and 89 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,833,631 to Nguyen.

In regards to claims 22, 30 and 34, Nguyen discloses a guide wire (Figure 2) including an elongate core (102) composed of a nickel-titanium alloy (Col. 5, lines 6 – 8), a proximal portion and a distal portion; a continuous unitary coil (204) composed of a second material (Col. 3, lines 56 – 67; Col. 4, lines 45 – 48) and that surrounds a substantial portion of the length of the core and extending distal of the core (Col. 4, lines 36 – 44); and a polymeric tip (206) contacting and extending from a distal portion of the coil, wherein the tip connects to the core by a polymeric material (Col. 4, lines 6 – 16). When shrunk, the polymeric material extends at least partially within spaces between adjacent turns of the coil. The coil comprises a coating (Col. 4, lines 6 – 7).

In regards to claims 57, 64, 68 and 89, Nguyen discloses a guide wire (Figure 2) including an elongate core (102) composed of a nickel-titanium alloy (Col. 5, lines 6 – 8), a proximal portion and a distal portion; a continuous unitary coil (204) composed of a second material (Col. 3, lines 56 – 67; Col. 4, lines 45 – 48) and that surrounds a substantial portion of the length of the core and extending distal of the core (Col. 4, lines 36 – 44); and a polymeric tip (206) extending from a distal

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portion of the coil, wherein the tip connects to the core by a polymeric material (202; Col. 3, lines 32 - 34). The coil comprises a coating (Col. 4, lines 6 - 7). The core as disclosed by Nguyen includes a constant diameter length.

Response to Arguments

3. Applicant's arguments filed 3/2/05 have been fully considered but they are not persuasive. Applicant asserts that Nguyen fails to disclose an elongate core having a constant diameter along its length. However the Examiner disagrees. Claim 57 merely sets forth the core including a constant diameter length. The tapered portion of the core only relates to the distal end portion of the guidewire as disclosed by Nguyen. The core includes a constant diameter length proximal of the distal end portion.

Allowable Subject Matter

4. Claims 70 - 88 are allowed.

5. Claims 25, 26, 28, 29, 32, 33, 35 - 39, 58 - 63, 65 - 67 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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